

REMARKS

For convenience, the headings used in the Action will be used in the present response.

Claim Objections

Claim 3 is objected as being improper because it does not further limit the claim (claim 2) from which it depends. Specifically, the range of average thickness of fibrils recited in claim 3 is broader than that recited in claim 2.

Claim 3 has been amended to recite a dependency on claim 1. Removal of the objection to the claim is in order.

Claim Rejections - 35 USC § 112

Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejections relate to recitations in claims 1 and 6.

Regarding claim 1, the recitation "using a filler" is stated to be indefinite because the claim does not specify how the filler is to be used. Claim 1 has been amended to limit the method to a method for manufacturing envelope paper comprising adding the filler to a fiber slush to be formed into the envelope paper. This amendment is supported, inter alia, by the description in the paragraph beginning on page 7, line 20, of the specification of the present application.

Regarding claim 6, the Office notes that the claim recites "inorganic salts" of the filler of claim 1, but the filler of claim 1 recites the filler as comprising "light-scattering material particles". This part of the rejection has been overcome by amending claim 6 to depend on claim 4 which limits the light-scattering material particles of the filler of claim 1 to inorganic salts.

Claim 6 is also rejected relating to the recitation "the proportion of inorganic salts of the weight of the filler". This rejection is believed to be overcome by amending the recitation in claim 6 as follows: "the proportion of inorganic salts ~~of the weight of the filler~~ is 75 - 85 % by weight based on the weight of the filler".

Removal of the 35 U.S.C. § 112, second paragraph, rejections of the claims is believed to be in order and is respectfully requested.

Claim Rejections - 35 USC § 102/103

Claims 1-10 are rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Silenius et al. (WO 02/92909).

Claims 1-10 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Silenius et al. (US 2004/0173329).

Claims 1-8 and 10 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Silenius et al. (WO 97/01670).

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Silenius et al. (WO 97/01670) in view of Silenius (European Patent No. 0930345 A2; hereinafter "Silenius").

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Silenius et al. (WO 97/01670) in view of J. Peel (Paper Science & Paper Manufacture; hereinafter "Peel").

Claim 1 has been amended, as noted above, to limit the method of the invention to a method for manufacturing an envelope paper by including the limitations of claim 10 in claim 1. Claim 10 has been canceled.

In the rejections of the claims, the Office notes that the references fail to disclose, i.e., do not anticipate, a method for manufacturing envelope paper. Thus, in view of the amendment to claim 1 to limit the method to a method for manufacturing an envelope paper, the 35 U.S.C. § 102 rejections are now believed to be moot.

Regarding the alternative rejections under 35 U.S.C. § 103(a), the position of the Office is that it would have been obvious to a person of ordinary skill in the art to make any kind of paper, including envelope paper, or that any kind of paper could be made into an envelope.

Applicants respectfully submit that envelope paper must exhibit particular properties, including light-weight, good strength properties, good printability and desired air-permeability. The data of the example and drawing of the present application show that these properties are unexpectedly obtained and, particularly, that air permeability and porosity that are independent of the amount of filler contained in the envelope paper, can be obtained by adding to the paper, a filler consisting at least in part of cellulose or lignocellulose fibrils on which there have been deposited light-scattering material particles, the proportion of the deposited light-scattering material particles being limited to a particular range. I.e., the data of the example and drawing of the present application show that air permeability and porosity that are independent of the amount of filler contained in an envelope paper can be obtained by limiting the deposited light-scattering material particles in the specified filler to 67 - 85 % of the weight of the filler.

The prior art fails to disclose or suggest any method for controlling air permeability and porosity in an envelope paper (or any paper) so as to be independent of the amount of filler contained in the envelope paper and, more particularly, fails to disclose or suggest any method for controlling air permeability and porosity in an envelope paper so as to be independent of the amount of filler contained in the envelope paper by adding to a fiber slush to be formed into the paper, a filler consisting at least in part of cellulose or lignocellulose fibrils on which there have been deposited light-scattering material particles, the proportion of the deposited light-scattering material particles being limited to 67 - 85 % of the weight of the filler.

Removal of the 35 U.S.C. § 102 and 35 U.S.C. § 103(a) rejections applied to claims 1-10 is believed to be in order and is respectfully requested.

Applicants note that a new claim, claim 11, directed to the method of the present invention has been added to the application for consideration by the Office. Claim 10 recites the method of the present invention in terms of a method for manufacturing a paper or board product which has an air permeability which varies at maximum by 10 %, the method comprising adding to a base web for the paper or board product, 10 % by weight to 30 % by weight, on

the basis of the weight of the mineral component and the weight of the web, of a filler consisting at least in part of cellulose or lignocellulose fibrils on which there have been deposited light-scattering material particles, the proportion of the deposited light-scattering material particles being 67 - 85 % of the weight of the filler. New claim 11 is believed to be supported, inter alia, by the description in the paragraph beginning in line 23 on page 3 of the specification of the present application and by original claim 7.

New claim 11 is believed to be patentable under 35 U.S.C. § 102 and 35 U.S.C. § 103(a) for essentially the same reasons as explained above in connection with claims 1-10 and to comply with the requirements of the first and second paragraphs of 35 U.S.C. § 112.

Favorable consideration of the patentability of claim 11 is respectfully requested.

Double Patenting

The claims are provisionally rejected on the ground of nonstatutory obviousness type double patenting (ODP) as being unpatentable over claims 12-18 of copending Application No 10/475,774; claims 12 and 16 of copending Application No.

PATENT APPLN. NO. 10/532,085
RESPONSE UNDER 37 C.F.R. §1.111

PATENT
NON-FINAL

10/475,773; claims 12-18 of copending Application No. 10/532,481;
and claims 16-22 and 24 of copending Application No. 11/808,273.

Applicants respectfully request that the ODP rejections be held in abeyance pending the determination of allowable subject matter in the present and copending applications.

The foregoing is believed to be a complete and proper response to the Office Action dated September 20, 2007.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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